

## REMARKS

In the Office action mailed September 6, 2005 ("Office Action"), the examiner rejects claims 1, 3, 5, 7, and 11. This reply adds claim 12. Thus, claims 1, 3, 5, 7, 11, and 12 are pending and under consideration.

### I. Response to § 103 rejections

The examiner rejects claims 1, 3, 5, 7, and 11 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,456,986 ("Boardman"). These rejections are respectfully traversed for the following reasons.

Boardman discusses a system for determining what to charge customers for certain transactions. Specifically, Boardman discusses calculating a charge for a telephone call (col. 2, ll. 20-22). However, Boardman does not teach or suggest numerous features of the claims.

Claim 1 recites a method for setting a support fee that includes "an inquiry with a computer support activity." Boardman does not teach or suggest anything comparable to this feature. Instead, Boardman only discusses calculating prices for telephone calls. A telephone call does not correspond to an inquiry with a computer support activity.

Claim 1 also recites "a support person" and a "support" fee. Boardman does not teach or suggest anything comparable to this feature. As discussed above, Boardman relates to pricing telephone calls and does not teach anything comparable to an inquiry for a computer support activity.

Claim 1 also recites features pertaining to a point system, conversion tables, and basing a fee on actual costs. The examiner admits that Boardman does not teach or suggest these features (Office Action, p. 4, ll. 4-6). Although the examiner is unable to provide any references related to these features, the examiner takes official notice that these features are well known. As explained below, the examiner's action is improper. Thus, claim 1 is also allowable because Boardman does not teach these features and because these features were not well known in the art at the time of the invention.

Claim 1 was amended by the reply filed March 17, 2005 to include additional features. The current rejection fails to consider any of the features added to claim 1. In fact, the current rejection is virtually identical to the rejection made before the features were added. Thus, the

rejection of claim 1 is improper also because the examiner fails to consider these features added to claim 1.

The rejection is also improper because the examiner fails to articulate a proper motivation to modify. The examiner asserts that one would have modified Boardman "in order to increase revenue by enticing customers into purchasing excess support coverage in order to avoid shortfalls, similar to the pricing scheme/model commonly used with mobile phone." First, the examiner fails to provide any proof that this benefit would result from the modification the examiner proposes. Second, Boardman already teaches a method of pricing mobile phone calls. Thus, the examiner seems to suggest that one would have modified Boardman to add a feature that Boardman already possesses. Third, as the examiner fails to provide a source for this motivation, it appears the examiner employs improper hindsight by looking to the applicant's specification for a reason to modify.

Claim 3, 5, and 7, are allowable over Boardman at least because they depend upon a claim that is allowable over Boardman. Claim 11 is allowable at least because it comprises at least one feature similar to a feature discussed above.

## **II. Traversal of official notice**

The examiner states that "a point system with a point-to-grade conversion table, and basing a fee on an actual cost, are two well known, hence obvious, elements to include in any method of setting fee/pricing structure, and official notice to that effect is hereby taken." The applicant respectfully traverses the examiner's statement and demands the examiner to produce authority for the statement. The applicant specifically points out the following errors in the examiner's action.

First, the examiner uses common knowledge as the principal evidence for the rejection. As explained in the M.P.E.P.,

any facts so noticed should . . . serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

M.P.E.P. § 2144.03(E).

Second, the noticed fact is not considered to be common knowledge or well-known in the art. In this case, the limitation is not of notorious character or capable of instant and

unquestionable demonstration as being well-known. Instead, this limitation is unique to the present invention. See M.P.E.P. § 2144.03(A) ("the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute").

Third, there is no evidence supporting the examiner's assertion. See M.P.E.P. § 2144.03(B) ("there must be some form of evidence in the record to support an assertion of common knowledge").

Fourth, it appears that the examiner also bases the rejection, at least in part, on personal knowledge. The examiner is required under 37 C.F.R. § 1.104(d)(2) to support such an assertion with an affidavit when called for by the applicant. The applicant calls upon the examiner to support the examiner's assertions with an affidavit.

### **III. Response to § 101 rejections**

The examiner rejects claims 1, 3, 5, 7, and 11 under 35 U.S.C. § 101. These rejections are respectfully traversed.

The examiner cites *In re Warmerdam* and asserts that the claims are non-statutory because they do not produce any "useful, concrete, and tangible result." First, the applicant respectfully requests the examiner to point out where *In re Warmerdam* provides the holding the examiner relies upon. Instead of *In re Warmerdam*, the examiner appears to cite a rule from *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998). In *State Street*, the court upheld claims directed to calculating a share price (see M.P.E.P. § 2106(II)(A)). As the present claims are directed to a "computed" "support fee", the present claims are also statutory for at least the same reasons the claims considered in *State Street* are statutory.

The Examiner also rejects the claims for failure to satisfy a requirement that the claims be directed to "technological arts". In the precedential decision of *Ex Parte Lundgren*, Appeal 2003--2088 (October 2005), the USPTO Board of Patent Appeals and Interferences ruled "that there is currently no judicially recognized 'technological arts' test to determine patent eligible subject matter under § 101." The Board also specifically indicated that the non-precedential decision of *Ex Parte Bowman* was not a binding decision. For this reason, it is respectfully requested that the rejection be withdrawn for lack of a foundation in the law.

#### IV. New claim 12

This reply adds claim 12. Claim 12 is allowable over Boardman at least because Boardman does not teach or suggest all the features claim 12 comprises.

#### V. Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with the filing of this reply, please charge them to Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 12/5/05

By: *Skip Gain*

E. F. C. Gain Jr.  
Registration No. 55, 917

1201 New York Avenue, NW, Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500